

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

Paper No. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PETER RONNBERG,
CARLBARK OLLE,
and
LARSSON BJORN

Appeal No. 1998-3367
Application No. 08/545,717

HEARD: SEPTEMBER 13, 2000

Before COHEN, STAAB, and NASE, *Administrative Patent Judges*.
STAAB, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 1, 2 and 4-13. Claim 14, the only other claim currently pending in the application, has been withdrawn from further consideration at this time under 37 CFR § 1.142(b) as not being readable on the elected species.

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Appellants' invention pertains to a garment having an absorbent section and a waist belt attached directly thereto. Of particular interest to appellants is the provision of a garment of the type noted that includes a waist belt having a stiffness within a specific range. A further understanding to the invention can be derived from a reading of exemplary claim 1, which appears in an appendix to appellants' main brief.

The single reference of record relied upon by the examiner in support of rejections under 35 U.S.C. § 102(b) and 35 U.S.C.

§ 103 is:

Gipson et al. (Gipson) 4,964,860 Oct. 23,
1990

Claims 1, 2 and 4-13 stand rejected under 35 U.S.C. § 112, first paragraph, as being based on a specification that "does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention" (answer, page 4).

Claims 1, 2, and 4-13 stand further rejected under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under

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35 U.S.C. § 103 as being unpatentable over Gipson.

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Reference is made to appellants' main and reply briefs (Paper Nos. 15 and 18) and to the examiner's answer (Paper No. 16) for the respective positions of appellants and the examiner regarding the merits of these rejections.

The 35 U.S.C. § 112, first paragraph, rejection

The test for compliance with the enablement requirement found in the first paragraph of 35 U.S.C. § 112 is whether the disclosure, as filed, is sufficiently complete to enable one of ordinary skill in the art to make and use the claimed invention without undue experimentation. *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988); *In re Scarbrough*, 500 F.2d 560, 566, 182 USPQ 298, 303 (CCPA 1974). The experimentation required, in addition to not being undue, must not require ingenuity beyond that expected of one of ordinary skill in the art. *See In re Angstadt*, 537 F.2d 498, 504, 190 USPQ 214, 219 (CCPA 1976). The examiner has the initial burden of producing reasons that substantiate a rejection based on lack of enablement. *In re Strahilevitz*, 668 F.2d 1229, 1232, 212

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USPQ 561, 563 (CCPA 1982), and *In re Marzocchi*, 439 F.2d 220,
223-24, 169 USPQ 367, 369-70 (CCPA 1971).

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Claim 1, the sole independent claim on appeal requires, in part, that the waist belt "has a stiffness of between 25 g and 90 g as measured by the modified version of test ASTM D 4032-82 CIRCULAR BEND PROCEDURE."

The examiner's rationale in rejecting the appealed claims as being based on a disclosure that does not satisfy the enablement requirement found in the first paragraph of 35 U.S.C. § 112 is found on page 4 of the answer and reads as follows:

The disclosure states that the waist belt has a specific bending stiffness calculated on [a] modified version of the test ASTM D 4032-82 CIRCULAR BEND PROCEDURE and that the belt is made of non-woven material. However, the Specification does not disclose of what the belt is made, i.e., [] the make-up of the belt being polypropylene, polyester, or some other type of polymer. It does not even disclose one procedure or component that the belt is made of. Appellant's [sic, Appellants'] claims relies [sic] on a *considerably modified* version of an ASTM test. It would take undue experimentation to find a material which falls within the requirements of Appellant's [sic, Appellants'] claims. [Emphasis in original.]

It thus appears that the examiner's rejection is founded

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on two points, namely, that (1) the skilled artisan would not know where to start in looking for a material that might satisfy the stiffness requirement of the claims, and (2) the skilled artisan would not know what constitutes the "modified" version of test ASTM D 4032-82 CIRCULAR BEND PROCEDURE used to measure stiffness.

As to (1), we note at the outset that appellants' invention is not technologically complex. The claims are directed to a garment having an absorbent section and a waist belt, and the specification informs us that the garment in question is suitable for use in adult incontinence applications (specification, page 2). Appellants assert (main brief, page 5), and we agree, that the industry concerned with making absorbent garments is a crowded and highly developed art. We further note, as did appellants, that the examiner acknowledges that the specific material from which the present invention is made is not essential to the invention (answer, page 9). In addition, the declaration of co-inventor Ronnberg executed on September 23, 1997 (Paper No. 10), indicates that polyethylene and polypropylene, traditional materials in this art whose

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properties an artisan would be well versed in, would be appropriate materials for forming a belt having the claimed stiffness. In light of the above, we believe the ordinarily skilled artisan would be well informed as to where to begin in locating materials to effect the claimed stiffness.

Concerning (2), the specification of the present application on pages 2-4 reasonably appears to fully inform a skilled artisan of how to perform the "modified version" of the ASTM-D 4032-82 test used by appellants to determine stiffness. In explaining this modified ASTM test, reference is made on pages 2-3 of the specification to published European application EP-A-0 336 578, which published application is incorporated by reference into appellants' disclosure.¹ To the extent there is any matter in EP-A-0 336 578 essential to an understanding of the "modified version" of the ASTM test used by appellants to determine stiffness that does not appear in the specification of the present application, that essential matter should be added to appellants' specification in order to comply with the completeness requirements set forth in

¹A copy of this published Europe patent application is of record in the application.

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§ 608.01(p).²

While appellants' disclosure may require the use of some experimentation in order to make the claimed invention, for the reasons expressed above, we conclude that undue experimentation would not be required. Accordingly, we will not sustain the standing § 112 rejection of the appealed claims.

The rejections based on Gipson

The appealed claims also stand rejected under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. § 103 as being unpatentable over Gipson.

Considering first the question of anticipation under 35 U.S.C. § 102(b), the examiner's position that the waist belt of Gipson *appears* to inherently have the same stiffness as called for in claim 1 is speculative. Since mere

²A copy of this section of the Manual is attached to this opinion for the convenience of appellants and the examiner. Note, in particular, that "essential material" may be incorporated by reference to a U.S. patent or a pending U.S. application, and that "nonessential material" may be incorporated by reference to, among others, patent applications published by foreign countries or regional patent offices.

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possibilities or even probabilities are not enough to establish inherency, the rejection of the appealed claims as being anticipated by Gipson cannot be sustained. See *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981).

Turning to the alternative rejection of the appealed claims as being unpatentable over Gipson, appellants' specification indicates that the belt should not be too flexible because the belt would be prone to excessive wrinkling which could be painful, nor should the belt be too stiff because the belt would then cause problems of cutting and abrasion (specification, page 2). Appellants' specification further indicates that with a belt

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stiffness between 25 g and 90 g, it is possible to achieve good handling characteristics (specification, page 5).

Turning to Gipson, we appreciate that Gipson does not expressly state what the stiffness of the waist belt is as measured by the modified ASTM test used by appellants. Nevertheless, it is self-evident that Gipson's waist belt has some stiffness value as measured by that standard. The characteristics of the waist belt of concern to Gipson are discussed in columns 3 and 4. We are informed at column 3, lines 10-17, that the belt should not be too wide nor too narrow, least it fail to provide for adequate adjustment to fit the wearer or interfere with leg movement of the wearer. Column 3, lines 24-25, states that the waist belt should be nonirritating to the skin. From column 3, lines 49-50, we learn that the belt can be of single or double thickness. At column 4, lines 28-41, it is stated that the sides of the waist belt may be reinforced, but that in so doing, the reinforcement should be smooth, nonirritating to the skin, and not provide an undue increase in thickness, because otherwise the wearer could experience discomfort.

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Based on the above teachings of Gipson, we are convinced that one of ordinary skill in the art would have recognized that there is a correlation between the thickness, and thus the stiffness, of the waist belt and wearer comfort. That is, the ordinarily skilled artisan would have recognized waist belt thickness, and thus stiffness, to be a result effective variable with respect to wearer comfort. Generally, it is considered to have been obvious to develop workable or even optimum ranges of such variables. *See, for example, In re Boesch*, 617 F.2d 272, 276, 205 USPQ 215, 219 (CCPA 1980); *In re Antonie*, 559 F.2d 618, 620, 195 USPQ 6, 8-9 (CCPA 1977); *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). The issue in the present case, where the patentability of the claims is predicated on the particular range of a parameter, is similar to the patentability issue in *In re Woodruff*, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936-37 (Fed. Cir. 1990). In that case, the Court stated:

The law is replete with cases in which the difference between the claimed invention and the prior art is some range or other variable within the claims

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[citations omitted]. These cases have consistently held that in such a situation, the appellant must show that the particular range is *critical*, generally by showing that the claimed range achieves unexpected results relative to the prior art range.

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Since appellants have not demonstrated or even alleged that the specifically claimed stiffness range set forth in claim

1 produces unexpected results, it is our conclusion that it would have been obvious for an artisan with ordinary skill to determine a workable or even optimum stiffness range for the waist belt of Gipson and thereby produce the garment of claim 1.

In light of the above, under 35 U.S.C. § 103 we will sustain the examiner's rejection of claim 1 as being unpatentable over Gipson. We will also sustain the rejection of claims 2, 4-7 and 9-13 as being unpatentable over Gipson, since appellants concede that these dependent claims stand or fall with claim 1. See page 4 of the main brief.

Claim 8 depends from claim 1 and adds that one of the belt portions has an elongated hook element attachment strip attached thereto and lying with a larger dimension thereof in the belt width direction whereby the larger dimension of the attachment strip has a length of between 25% and 75% of the belt width. Appellants' specification explains that the dimension of the attachment strip that aligns with the width

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of the belt may be less than the belt's width to reduce to the greatest possible extent the possibility of the hook elements contacting the wearer's skin and irritating the wearer (specification, page 7).

In rejecting this claim, the examiner points appellants' attention to Figure 3 of Gipson. This figure shows attachment strips 18 of the absorbent assembly 14 being spaced away from the edges of the flaps 26. Gipson explains the significance of this placement as follows:

Each patch 18 may be spaced inwardly from the lateral and longitudinal edges of the flaps 26 at least approximately 0.6 centimeters, to provide for variations in positioning during manufacture and obviate the rough edge of the patch 18 from contacting and irritating the skin of the wearer. The patches 18 may be polygonol [sic], preferably rectangular in shape. Such shape preferably has a greater lateral dimension than longitudinal dimension, with the longitudinal dimension being less than the width of the belt 12, to provide for longitudinal adjustment of the disposable assembly 14 relative to the belt 12. [Column 6, line 63, through column 7, line 6; emphasis added.]

While Gipson's drawing figures do not show the attachment strips 18 of the waist belt as being spaced inwardly from the

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lateral and longitudinal edges of the belt, we believe it would have been obvious to one of ordinary skill in the art to likewise size and locate the patches 18 of the waist belt so that they are spaced from the edges of the belt to gain the same advantages discussed by Gipson with respect to the placement of the patches 18 of the absorbent assembly, namely, to obviate the rough edges of the patches 18 from contacting and irritating the skin of the wearer. As to the requirement of claim 8 that the larger dimension of the attachment strip has a length of between 25% and 75% of the belt width, to the extent that modifying Gipson's patches 18 on the belt in accordance with the above noted teachings of Gipson would not result in the patches of the waist belt meeting the rather broad range limitation set forth in claim 8, that range is considered to be an obvious matter of design choice. See *In re Kuhle*, 526 F.2d 553, 555, 188 USPQ 7, 8-9 (CCPA 1975). This view is bolstered by appellants' specification, which states that the claimed range of 25% to 75% is merely "preferable" (see page 7, line 24).

For these reasons, we also will sustain the examiner's

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rejection of claim 8 as being unpatentable over Gipson.

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Summary

The rejection of claims 1, 2 and 4-13 under 35 U.S.C. § 112, first paragraph, is reversed.

The rejection of claims 1, 2 and 4-13 under 35 U.S.C. § 102(b) as being anticipated by Gipson is reversed.

The rejection of claims 1, 2 and 4-13 under 35 U.S.C. § 103 as being unpatentable over Gipson is affirmed.

Since at least one rejection of each of the appealed claims has been affirmed, the decision of the examiner finally rejecting the appealed claims is affirmed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

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IRWIN CHARLES COHEN))
Administrative Patent Judge)	
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)	BOARD OF PATENT
LAWRENCE J. STAAB)	
Administrative Patent Judge)	APPEALS AND
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)	INTERFERENCES
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JEFFREY V. NASE)	
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